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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/204,390 12/02/98 EVERLING

D P/2167-61

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LM01/0128

EXAMINER

TEITELBAUM, A

ART UNIT

PAPER NUMBER

2765

DATE MAILED:

01/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/204,390

Applicant(s)

EVERLING ET AL.

Examiner

Anne Teitelbaum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on 02 December 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 1998 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

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DETAILED ACTION

Claims 1-21 have been examined.

Specification

The disclosure is objected to because of the following informalities: On page 6, lines 10-11 and line 12, the 'Merchant Acquirer' is referenced with number "135", which is the 'Issuer'. The correct reference number for the 'Merchant Acquirer' is "120".

Please ensure that the rest of the disclosure concurs with the drawings. Appropriate correction is required.

The abstract of the disclosure is objected to because there are several grammatical errors. For example lines 6-8, examiner interprets this sentence to be "The issuer eliminates transactions on cards issued by the issuer and eliminates any duplicate non-issuer card numbers." Correction is required. See MPEP § 608.01(b).

Oath/Declaration

It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and ***first*** inventor or inventors of the subject matter which is claimed and for which a patent is sought.

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Drawings

The drawings are objected to because on Figure 3, the Issuer (135) is not visible.
Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawlor et al (U.S. Patent No. 5,870,724).

Claim 1:

A method for processing transaction data comprising the steps of:
receiving transaction data, the transaction data containing account numbers (col 29, lines 12-13);
identifying non-issuer account numbers which represent accounts not issued by an issuer (col 4, lines 13-16 teaches accessing accounts from other banks in a

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database, which constitutes non-issuer accounts since these account are from different banks than the one the user has an account with); and

matching the identified non-issuer account numbers with account numbers representing account issued by the issuer (col 13, lines 51-54 and figure 1 teaches "a system architecture that permits a combination of information access").

Claim 2:

A method wherein the matching steps comprises:

identifying a consumer associated with at least one of the identified non-issuer account numbers (figure 10 teaches the users being identified in reference 366);

determining if the identified consumer is a customer of the issuer, the customer having an issuer account number representing an issuer account issued by the issuer (figure 10 teaches the system checking to see if the user is a member, reference 368-370); and

linking the non-issuer account number of the customer with the issuer account number of the customer (col 35, lines 18-25 teaches linking a unique identifier with the users account number which has the same function of checking through the records of other financial institutions, that the applicant claims).

Claim 3:

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maintaining a database containing issuer account numbers representing issuer accounts of customers of an issuer, and containing customer non-issuer account numbers representing non-issuer accounts of the customers (col 13, lines 58-59 teaches maintaining a database with account information, such as account numbers. It is inherent to the database that the non-issuer account numbers be maintained, for example an ATM machine can provide service for a customer of a non-issuing institution. In order for this to occur, the customer's non-issuer account number needs to be maintained locally for the issuing bank to use in order to provide transactions for that customer.)

Claim 4:

adding the matched non-issuer account numbers to the database as customer non-issuer account numbers (col 20, lines 9-10 teaches the function of updating a database by adding files, which is a common function of a database).

Claim 5:

database further contains historical transaction data representing previous transactions performed by the customer using a non-issuer account, the method further comprising the step of (col 7, lines 4-5 teaches maintaining a database while col 20, lines 11-19 teaches the functions the database can perform on the customer transaction profiles which contain previous transactions performed by the customer):

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updating the historical transaction data in the database by adding received transaction data, which contains matched non-issuer account numbers (col 20, lines 11-15 teaches updating the transaction database).

Claim 6:

performing queries on the database (col 20, lines 15-19 teaches a query program for the database).

Claim 7:

determining the use of the non-issuer account by the customer in response to a result of the query (col 20, lines 16-19 teaches that the query program “permits analysis and specialized report generation concerning transaction profiles”. This shows a program capable of determining the use of the account through a query.).

Claim 8:

marketing services of the issuer to the customer in response to the determined use by the customer (col 6, lines 60-61 and col 13, lines 55-57 teaches targeting advertisement to users “based on spending patterns”).

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al (U.S. Patent No. 5,870,724) in view of Pascoe (U.S. Patent No. 5,813,015).

Claim 9:

Lawlor discloses the method for processing transaction data. However, Lawlor fails to disclose the "scrubbing" action taken on the transaction files. Pascoe discloses a method for "scrubbing" a file that eliminates files (col 3, lines 24-34). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Lawlor and Pascoe because "scrubbing" is an effective and common method for eliminating files. "Scrubbing" or filtering files is an old and well-known method in the computer art. It is beneficial to eliminate transaction data, which contains duplicate account numbers because it is redundant and wastes storage space in the system. It is efficient to eliminate transaction data containing account number issued by the user because the purpose of this system is to look at non-issuer accounts and therefore the issued accounts are an inconvenience and also take up valuable, usable space in the system.

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Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Konya (U.S. Patent No. 5,937,396) in view of Pascoe (U.S. Patent No. 5,813,015).

Claim 10:

receiving new transaction data, the new transaction data representing new credit transactions and comprising records containing at least account numbers of accounts which initiated the new credit transactions (Konya col 6, lines 9-11, 18-20, col 7, lines 58-61 and col 12, lines 43-44 teaches a database, which can receive new data, containing information on a plurality of banks and customer transaction data);

associating by customer, the non-issuer account numbers with issuer account numbers (col. 11, lines 62-65).

However, Konya does not disclose eliminating new transaction data containing issuer account numbers, the issuer account numbers representing issuer accounts of customers of an issuer (Pascoe, col 3, lines 24-34) and generating a list of account numbers contained in the new transaction data which are not issuer account numbers (Pascoe, col 4, lines 29-30). These steps comprise a well-known method in the computer art known as "scrubbing". The "scrubbing" method is shown in claim 9 by Pascoe and is therefore rejected on the same analysis. Konya's method of processing transaction deals with a plurality of financial institutions as does Lawlor and can therefore be combined with Pascoe for the same reasoning.

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Konya also does not disclose generating a list of account numbers contained in the new transaction data, which are not issuer account numbers. Official notice is taken that it is old and well known in the computer art to generate a new list with information from an original list, based on a common feature, in this case the issuer of the account. Therefore, it would have been obvious to a person of ordinary skill in the art to generate a new list of non-issuer accounts in order that unnecessary information is not visible or inconvenient.

Konya also does not disclose identifying account numbers in the list which represent accounts owned by the customers, the identified account numbers being denoted as non-issuer account numbers. However, Pascoe teaches searching through the files based on search parameters or criteria (col 4, lines 8-10 and 27-29), which in this case would be issuer or non-issuer account numbers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Konya and Pascoe. A searching function is useful to make the processing easier and more efficient.

Claims 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konya (U.S. Patent No. 5,937,396) in view of Pascoe (U.S. Patent No. 5,813,015) as applied to claim 10 above, and further in view of Lawlor (U.S. Patent No. 5,870,724).

Claim 11:

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This claim comprises the same steps as claim 3 and is therefore rejected on the same analysis.

Claim 12:

This claim comprises the same steps as claim 4 and is therefore rejected on the same analysis.

Claim 13:

This claim comprises the same steps as claim 5 and is therefore rejected on the same analysis.

Claim 14:

This claim comprises the same steps as claim 6 and is therefore rejected on the same analysis.

Claim 15:

This claim comprises the same steps as claim 7 and is therefore rejected on the same analysis.

Claim 16:

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This claim comprises the same steps as claim 8 and is therefore rejected on the same analysis.

Claim 17:

This claim comprises the same steps as claim 9 and is therefore rejected on the same analysis.

Claim 18:

This claim comprises the same steps as claims 3, 5, 10, 12 and 17 and is therefore rejected on the same analysis.

Claim 19:

This claim comprises the same steps as claim 6 and is therefore rejected on the same analysis.

Claim 20:

This claim comprises the same steps as claim 7 and is therefore rejected on the same analysis.

Claim 21:

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This claim comprises the same steps as claim 8 and is therefore rejected on the same analysis.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Gerace (5,991,735) discloses a computer network that targets appropriate audiences through use of behavioral profile of computer users.
- Daly et al (5,878,141) discloses a computerized electronic purchasing system over a network utilizing databases of merchants and buyers.
- Rose et al (5,770,843) discloses a system for determining the identity of a user based on a PIN number.
- Yu (5,748,908) discloses an automated, classified expenditure data card recording system that deals with various merchants and their banks.
- Dedrick (5,717,923) discloses a method for sending customized electronic information.
- Dedrick (5,710,884) discloses a method for storing and updating electronic information in a personal profile.
- Tannenbaum (5,521,363) discloses a system with a memory card to track a customer's account transactions.

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- Sullivan (5,351,296) discloses a system for transmitting financial account codes over a communications network.

- Cuervo (5,025,138) discloses a system for providing a verifiable line of credit information.

- Sunych (4,939,352) discloses a credit card billing system involving a plurality of credit cards with a branch computer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Teitelbaum whose telephone number is (703) 306-5679. The examiner can normally be reached on Monday-Thursday from 7:30am to 5:00pm and on alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald can be reached on (703) 305-9708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) -308-9051 or 9052 for regular communications and (703) 308-5337 for After Final communications.

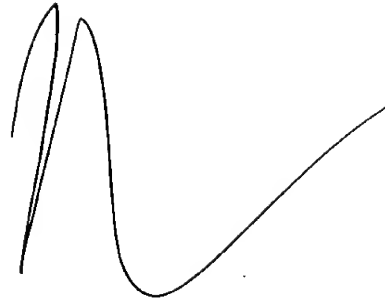
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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aht
January 27, 2000

A handwritten signature in black ink, consisting of a stylized 'A' followed by a long, sweeping horizontal stroke that curves upwards at the end.

ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER